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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,105	12/05/2003	Kimberly A. Savary	21246	3066
210	7590	09/12/2005	EXAMINER	
MERCK AND CO., INC			SOLOLA, TAOFIQ A	
P O BOX 2000			ART UNIT	
RAHWAY, NJ 07065-0907			PAPER NUMBER	

1626

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,105

Applicant(s)

SAVARY ET AL.

Examiner

Taofiq A. Solola

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 16 is/are allowed.
- 6) ☐ Claim(s) 1, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) 2-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: ____ |

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Claim 1-16 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Walton, US 3,480,613.

Walton discloses compound XI, in col. 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 14-15 are rejected under 35 U.S.C. 103(a) as being obvious over Walton, US 3,480,613 and Wolfe et al., Tetrahedron. Letters, (1995), Vol. 36, No. 42, pages 7611-14, individually (claim 1).

In claim 1, Applicant claims deprotection of protected oxygen atom in compound of formula V to make compound of formula I. Applicant does not claim how the process is performed. In claims 14 and 15, Applicant claims compounds shown in the claims.

Determination of the scope and content of the prior art (MPEP §2141.01)

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Walton teaches a process for deprotecting protected oxygen atoms in a compound using methanol or ammonia. See col. 11, lines 25-26 and 36-40. Wolfe et al., teach a process of deprotecting protected oxygen atoms in a compound using methanolic ammonia. See page 7612, last paragraph, lines 2-3. Walton also teaches compound XI, in col. 5.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant process and that of Walton and Wolfe et al., is that the compound deprotected by Applicant has similar but not exact structure as the compounds of Walton and Wolfe et al. Also, the compounds claimed by applicant in claims 14 and 15 have alkyl instead of H, in the compound of Walton, at position R2.

Finding of prima facie obviousness---rational and motivation (MPEP §2142.2413)

Applicant's deprotected compound and that of Walton and Wolfe et al., are deemed analogous starting materials. The use of an analogous starting material in a well-known process is prima facie obvious. *In re Durden*, 226 USPQ 359, (1985). Also, H and alkyl are art recognized equivalents. *In re Lincoln*, 126 USPQ 477, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960). Therefore, the instant invention is prima facie obvious from the teachings of Walton and Wolfe et al. One of ordinary skill in the art would have known to claim the deprotection of oxygen, and alkyl instead of H, at the time the invention was made. The motivation is from well-known processes of deprotecting oxygen atom, and knowing that H and alkyl are equivalents.

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Allowable Subject Matter

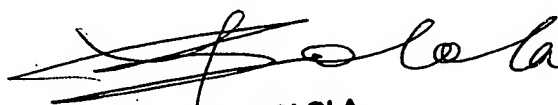
Claims 2-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 16 is allowable over prior arts of record.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Taofiq Solola', with a stylized flourish at the end.

**TAOFIQ SOLOLA
PRIMARY EXAMINER**

Group 1626

September 7, 2005